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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,844	08/22/2003	Michael R. Duff	31735/70009 CON	8141
23643	7590	05/27/2004	EXAMINER	
BARNES & THORNBURG 11 SOUTH MERIDIAN INDIANAPOLIS, IN 46204			GHALI, ISIS A D	
			ART UNIT	PAPER NUMBER

1615

DATE MAILED: 05/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/645,844

Applicant(s)

DUFF ET AL.

Examiner

Isis Ghali

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 41-50 is/are pending in the application.
- 4a) Of the above claim(s) 41, 42 and 44-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 08/22/2003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

The receipt is acknowledged of applicants' IDS, filed 08/22/03; and amendment, filed 04/28/2004.

#### ***Election/Restrictions***

1. Applicant's election with traverse of Group III, claim 43 is acknowledged. The traversal is on the ground(s) that the inventions are not disclosed as capable of use separately or having different modes of operation and specifying one material in one group but not in the other does not indicate the groups have different mode of function or effect. This is not found persuasive because while the groups seem to be overlapping this does not indicate the search would not be extensive because the patent examiner searches the databases mostly literally. The reference that anticipates one group not necessary anticipates the other groups. The search system and the focus of the invention are completely different, requiring an undue burden on the patent examiner. Rarely do applicants present claims to an inventions where the distinctness of the invention are readily clear such as a chemical compound and a gene sequence. It is the responsibility of the examiner to enforce 35 USC 101, which allows the applicant to obtain a patent for a single invention. In the opinion of the examiner the applicants present three distinct inventions.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 41, 42, 44-50 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected groups, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 43 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claim recites a new matter that was not disclosed in the specification as originally filed and that is the step of contacting one finger or the thumb of the individual with the saturated towlette.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 1038 and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

7. Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Furman (US 5,451,404) in view of "Merck Index".

Furman teaches a coolant composition comprising ketal, menthol and carboxamides (stimulating organic substances), incorporated into carrier and are suitable for applying or exposure to the skin and/or mucosal membrane in topical compositions that included cleansing tissues, i.e. towelette (abstract; col.2, lines 25-51; col.4, lines 38 till col.5, line 45; col.5, lines 60-61). The composition is suitable for medical or other reasons and produces the cooling effect when contacts the mucosa or nose or throat by direct or indirect application or inhalation (col.6, lines 1-20). According to the applicants disclosure in page 10, lines 1-8, the stimulating organic substances are the substances that cause a sensation as a result of other sensory mechanism, for

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example a topical cooling sensation or olfactory sensation, these substances can be utilized as long as the sensation cause a decrease in the drowsiness of the individual.

However, the reference does not teach the ammonia containing substance.

Merck Index teaches that ammonia causes irritation of the eye, nose and throat.

Thus, it would have been obvious to one having ordinary skill in the art at the time of the invention to deliver the tissue impregnated with an stimulating organic substance as disclosed by Furman, and add ammonia to the composition motivated by the teaching of Merck Index that the ammonia is irritant to the eye and nose, with reasonable expectation of having a sensory stimulation that decrease drowsiness.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isis Ghali whose telephone number is (571) 272-0595. The examiner can normally be reached on Monday-Thursday, 7:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Isis Ghali  
Examiner  
Art Unit 1615

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*Isis Ghali*

ISIS GHALI  
PATENT EXAMINER